

REMARKS

Claims 5 and 15 are canceled without prejudice, and therefore claims 1 to 4, 6 to 14, and 16 to 75 are now pending.

It is respectfully requested that the Examiner acknowledge acceptance of the drawings, and acknowledge the foreign priority claim and the receipt of the priority documents in the next Office communication.

Applicants thank the Examiner for acknowledging the previously filed IDS and PTO-1449 papers and related references.

With respect to paragraph three (3), Applicants thank the Examiner for allowing claims 24 to 75, and for indicating that claims 4 to 13 and 15 to 23 contain allowable subject matter (so that these claims were only objected to in the Office Action). While the rejections may not be agreed with, to facilitate matters, claim 1 has been rewritten to include the features of claim 5, which has been canceled without prejudice. Claims 6, 7, and 13 now depend from claim 1, and not canceled claim 5. Also, claim 14 has been rewritten to include the features of claim 15, which has been canceled without prejudice. Claims 16, 17, and 23 now depend from claim 14, and not canceled claim 15. Accordingly, claims 1 to 4, 6 to 14, and 16 to 23 are allowable. It is therefore respectfully requested that the objections be withdrawn as moot.

With respect to paragraph two (2), claims 1 to 3 and 14 were rejected under 35 U.S.C. § 102(b) as anticipated by Kramer et al., U.S. Patent No. 5,901,085.

As regards the anticipation rejections of the claims, to reject a claim under 35 U.S.C. § 102, the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. (*See Scripps Clinic & Research Foundation v. Genentech, Inc.*, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991). Still further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed invention, namely the claimed subject matter of the claims, as discussed herein. (*See Akzo, N.V. v. U.S.I.T.C.*, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)).

As further regards the anticipation rejections, to the extent that the Office Action may be relying on the inherency doctrine, it is respectfully submitted that to rely on inherency, the Examiner must provide a "basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics *necessarily* flows from the teachings of the applied art." (*See* M.P.E.P. § 2112; emphasis in original; and *see Ex parte Levy*, 17

U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int'f. 1990)). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic. Accordingly, it is respectfully submitted that any anticipation rejection premised on the inherency doctrine is not sustainable absent the foregoing conditions.

While the rejections may not be agreed with, to facilitate matters, claim 1 has been rewritten to include the features of claim 5, which has been canceled without prejudice. Claims 6, 7, and 13 now depend from claim 1, and not canceled claim 5. Also, claim 14 has been rewritten to include the features of claim 15, which has been canceled without prejudice. Claims 16, 17, and 23 now depend from claim 14, and not canceled claim 15. Accordingly, claims 1 to 4, 6 to 14, and 16 to 23 are allowable. It is therefore respectfully requested that the rejections of claims 1 to 3 and 14 be withdrawn.

It is therefore respectfully submitted that all of claims 1 to 4, 6 to 14 and 16 to 23 are allowable -- like allowed claims 24 to 75.

Conclusion

In view of the foregoing, it is believed that the objections and rejections have been obviated, and that claims 1 to 4, 6 to 14 and 16 to 23 are allowable -- like allowed claims 24 to 75. It is therefore respectfully requested that the objections and rejections be withdrawn, and that the present application issue as early as possible.

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Respectfully submitted,
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